

REMARKS

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed November 15, 2005. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 27 remain pending. In particular, Applicants amend claims 1, 9, and 15. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Derwich and Examiner Barron spent with Applicants' Attorney, Anthony Bonner during a telephone discussion on January 11, 2006 regarding the outstanding Office Action. During that conversation, Mr. Bonner indicated that the cited art fails to disclose the claimed element "determining, *at the e-mail server* whether the customer is associated with a valid IP address." Examiner Derwich defined the term "e-mail server" to be "any computer coupled to a LAN" and asserted that the Clark reference discloses a similar step that is performed at a firewall. Examiner Derwich further asserted that since the firewall of Clark can be a computer coupled to a LAN, the firewall of Clark is an e-mail server (despite the fact that the reference fails to provide any indication that the firewall can perform a single e-mail function). Mr. Bonner respectfully asserted that this is an improper definition of the term "e-mail server," but was told that an RCE must be filed to proceed in this case. Thus, Applicants respectfully request that Examiner Derwich carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

A. Claim 1 is Patentable Over Clark in View of Donaldson

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,442,588 (“*Clark*”) in view of U.S. Patent Number 6,321,267 (“*Donaldson*”). Applicants respectfully traverse this rejection for at least the reason that *Clark* in view of *Donaldson* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1, as amended recites:

A method for blocking unsolicited e-mail transmitted to an e-mail server at an Internet Service Provider (ISP), the method comprising:
receiving a user identification (USERID) and a password associated with a customer;
retrieving a plurality of data associated with the customer based on the USERID and password;
authenticating the customer using the retrieved plurality of data;
dynamically adding an IP address assigned to the customer to a plurality of valid IP addresses associated with the ISP;

receiving SMTP traffic from the customer;
in response to receiving the SMTP traffic, determining, at *the e-mail server, the e-mail server being configured to receive and maintain at least one e-mail*, whether the customer is associated with a valid IP address; and

in response to determining that the customer is associated with a valid IP address, logging the customer onto the e-mail server using the IP address and the plurality of data used to authenticate the customer, wherein only the customer may access the mail server using the assigned IP address. *(emphasis added)*

Applicants respectfully submit that claim 1, as amended, is allowable over the cited art for at least the reason that neither reference, individually or in combination discloses, teaches, or suggests a “method for blocking unsolicited e-mail transmitted to an e-mail server at an Internet Service Provider (ISP), the method comprising... in response to receiving the SMTP traffic, determining, at *the e-mail server, the e-mail server being configured to receive and maintain at least one e-mail*, whether the customer is associated with a valid IP address” as recited in claim 1, as amended.

More specifically, *Clark* discloses a dynamic filtering firewall that “acts as a barrier to prevent unauthorized access to the [online service provider] subscription services such as, but not limited to email, news, and personal web pages” (col. 4, line 46). However, nowhere in *Clark* is there any discussion of “in response to receiving the SMTP traffic, determining, at *the e-mail server, the e-mail server being configured to receive and maintain at least one e-mail*, whether the customer is associated with a valid IP address” as recited in claim 1, as amended. For at least this reason, claim 1, as amended, is allowable over the cited art.

Additionally, Applicants submit that *Donaldson* fails to overcome the deficiencies of *Clark*. For at least the reason that neither reference discloses, teaches, or suggest all of the

claimed elements, Applicants respectfully submit that claim 1, as amended, is allowable over the cited art.

B. Claim 9 is Patentable Over Clark in View of Donaldson

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,442,588 (“*Clark*”) in view of U.S. Patent Number 6,321,267 (“*Donaldson*”). Applicants respectfully traverse this rejection for at least the reason that *Clark* in view of *Donaldson* fails to disclose, teach, or suggest all of the elements of claim 9. More specifically, claim 9, as amended recites:

A method of preventing unsolicited e-mails from being transmitted via a mail server associated with the Internet Service Provider (ISP) of a customer, the method comprising:

receiving a user identification (USERID) and password, wherein the USERID and password are associated with the customer;

authenticating the customer as a registered user of the ISP;

generating a positive response if the customer is a registered user of the ISP;

receiving a START record indicating that the customer is being logged onto a Network Access Server (NAS);

writing the START record to a database;

receiving SMTP traffic from the customer for delivery to a recipient;

in response to receiving the SMTP traffic *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message*, whether an IP address assigned to the customer is valid; and

in response to determining that the IP address assigned to the customer is valid, forwarding the SMTP traffic to the recipient. (*emphasis added*)

Applicants respectfully submit that claim 9, as amended, is allowable over the cited art for at least the reason that neither reference, individually or in combination discloses, teaches, or suggests a “method of preventing unsolicited e-mails from being transmitted via a mail server

associated with the Internet Service Provider (ISP) of a customer, the method comprising... in response to receiving the SMTP traffic *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message*, whether an IP address assigned to the customer is valid” as recited in claim 9, as amended.

More specifically, *Clark* discloses a dynamic filtering firewall that “acts as a barrier to prevent unauthorized access to the [online service provider] subscription services such as, but not limited to email, news, and personal web pages” (col. 4, line 46). However, nowhere in *Clark* is there any discussion of “in response to receiving the SMTP traffic *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message*, whether an IP address assigned to the customer is valid” as recited in claim 9, as amended. For at least this reason, claim 9, as amended, is allowable over the cited art.

Additionally, Applicants submit that *Donaldson* fails to overcome the deficiencies of *Clark*. For at least the reason that neither reference discloses, teaches, or suggest all of the claimed elements, Applicants respectfully submit that claim 9, as amended, is allowable over the cited art.

C. Claim 15 is Patentable Over *Clark* in View of *Donaldson*

The Office Action indicates that claim 15 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,442,588 (“*Clark*”) in view of U.S. Patent Number 6,321,267 (“*Donaldson*”). Applicants respectfully traverse this rejection for at least the reason that *Clark* in view of *Donaldson* fails to disclose, teach, or suggest all of the elements of claim 15. More specifically, claim 15, as amended recites:

A method of logging on a customer of an Internet Service provider (ISP) onto a mail server while preventing the unauthorized distribution of SPAM messages via the mail server, the method comprising:

authenticating that the customer is a registered customer of the ISP;

storing a data log in a database, the data log comprising a plurality of attributes to track the customer's usage of the network connection;

receiving SMTP traffic from the customer;

in response to receiving the SMTP traffic, *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message*, whether as IP address assigned to the customer is valid; and

in response to determining that the IP address assigned to the customer is valid, connecting the customer to the mail server using the IP address. *(emphasis added)*

Applicants respectfully submit that claim 15, as amended, is allowable over the cited art for at least the reason that neither reference, individually or in combination discloses, teaches, or suggests a “method of logging on a customer of an Internet Service provider (ISP) onto a mail server while preventing the unauthorized distribution of SPAM messages via the mail server, the method comprising... *in response to receiving the SMTP traffic, determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message*, whether as IP address assigned to the customer is valid” as recited in claim 15, as amended.

More specifically, *Clark* discloses a dynamic filtering firewall that “acts as a barrier to prevent unauthorized access to the [online service provider] subscription services such as, but not limited to email, news, and personal web pages” (col. 4, line 46). However, nowhere in *Clark* is there any discussion of “*in response to receiving the SMTP traffic, determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message, whether as IP address assigned to the customer is valid*” as recited in claim 15, as amended.

For at least this reason, claim 15, as amended, is allowable over the cited art.

Additionally, Applicants submit that *Donaldson* fails to overcome the deficiencies of *Clark*. For at least the reason that neither reference discloses, teaches, or suggest all of the claimed elements, Applicants respectfully submit that claim 15, as amended, is allowable over the cited art.

D. Claims 2 – 8, 10 – 11, 13 – 14, 16 – 17, 19 – 23, and 25 – 27 are Patentable Over Clark in View of Donaldson

The Office Action indicates that claims 2 – 8, 10 – 11, 13 – 14, 16 – 17, 19 – 23, and 25 – 27 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,442,588 (“*Clark*”) in view of U.S. Patent Number 6,321,267 (“*Donaldson*”).

Applicants respectfully traverse this rejection for at least the reason that *Clark* in view of *Donaldson* fails to disclose, teach, or suggest all of the elements of these claims. More specifically, dependent claims 2 – 8, 19, and 20 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 10 – 11, 13 – 14, and 21 – 23 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. In addition, claims 16 – 17 and 25 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 15.

In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc., 303 F.3d 1294, 1299 (Fed. Cir. 2002).

E. Claims 12, 18, and 24 are Patentable Over Clark in View of Donaldson, Further in View of Amin

The Office Action indicates that claims 12, 18, and 24 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,442,588 (“*Clark*”) in view of

U.S. Patent Number 6,321,267 (“*Donaldson*”), further in view of U.S. Patent Number 6,854,014 (“*Amin*”). Applicants respectfully traverse this rejection for at least the reason that *Clark* in view of *Donaldson*, further in view of *Amin* fails to disclose, teach, or suggest all of the elements of these claims. More specifically, dependent claims 12 and 24 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Further, dependent claim 18 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 15. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

III. Allegedly Well Known Subject Matter

A. Claims 1 – 3 are Not Well Known

In addition, the Office Action states “*Clark* fails to teach a method that receives SMTP traffic from the customer. However, SMTP was well known in the art at the time of the Applicant’s invention...” (OA p. 3, last paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and

particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “in response to receiving the SMTP traffic *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message, whether an IP address assigned to the customer is valid*,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claims 1 – 3 are patentable in view of the cited art.

B. Claims 4 – 5 are Not Well Known

In addition, the Office Action states Clark “does not disclose the request to send e-mail using the SMTP protocol or a timestamp when the IP address is dynamically added to the pool. However, the use of SMTP and timestamps was well known in the art at the time of the invention” (OA p. 6, first paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding),

presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “in response to receiving the SMTP traffic *determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message, whether an IP address assigned to the customer is valid,*” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claims 4 – 5 are patentable in view of the cited art.

C. Claims 9 – 11 are Not Well Known

In addition, the Office Action states “Clark fails to teach a method that receives SMTP traffic from the customer. However, SMTP was well known in the art at the time of the Applicant’s invention...” (OA p. 5, first full paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the

Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “in response to receiving the SMTP traffic, determining, at *the e-mail server, the e-mail server being configured to receive and maintain at least one e-mail, whether the customer is associated with a valid IP address,*” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claim 12 is patentable in view of the cited art.

D. Claim 12 is Not Well Known

In addition, the Office Action states “Clark and Donaldson do not specify an account session ID, and account delay time, and a start timestamp. Nevertheless, including these in a START record was well known in the art at the time of the invention” (OA p. 7, second paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “in response to receiving the SMTP traffic, determining, at *the e-mail server, the e-mail server being configured to receive and maintain at least one e-mail, whether the customer is associated with a valid IP address*,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claims 9 – 11 are patentable in view of the cited art.

E. Claims 15 – 17 and 21 – 23 are Not Well Known

In addition, the Office Action states “Clark and Donaldson do not specify an account session ID, and account delay time, and a start timestamp. Nevertheless, including these in a START record was well known in the art at the time of the invention” (OA p. 7, second paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “*in response to receiving the SMTP traffic*, determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message, *whether as IP address assigned to the customer is valid*,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason,

Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claims 15 – 17 and 21 – 23 are patentable in view of the cited art.

F. Claims 18 and 24 are Not Well Known

In addition, the Office Action states “Clark fails to teach a method that receives SMTP traffic from the customer. However, SMTP was well known in the art at the time of the Applicant’s invention...” (OA p. 5, first full paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “*in response to receiving the SMTP traffic*, determining, at the mail server, the mail server being configured to receive and maintain at least one e-mail message, *whether as IP address assigned to the customer is valid*,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no

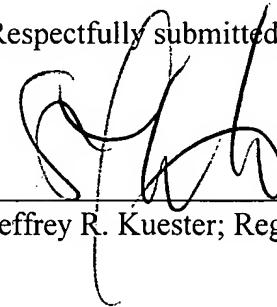
additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and submit that claims 18 and 24 are patentable in view of the cited art.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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